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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/161,401	09/28/1998	MITSUMASA SUGIYAMA	862.2471	7599

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

COLBERT, ELLA

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/161,401

Applicant(s)

SUGIYAMA, MITSUMASA

Examiner

Ella Colbert

Art Unit

3624

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 04 August 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,3-12 and 14-31.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Continuation of 2. NOTE: The Advisory Action of 1/13/03 is hereby withdrawn in view of a new Advisory Action. Applicant's Amendment adding new claims 32-34 raise new issues that will require further search and/or consideration. Claims 1, 3-12, and 14-31 have not been amended and remain rejected. As a preliminary matter, attached to this advisory action is the proper format for submitting amendments according to 37 CFR 1.121 (Revised Amendment Practice -July 30, 2003). It is noted that Claim 1 has grammatical errors. For example: Claim 1, lines 5 and 6 recite "determination means for determining if each of attribute items of attribute ... appended to the data corresponds to each of attribute items of the second database;" This claim limitation would be better recited "determination means for determining if each of the attribute items of the attribute ... appended to the data corresponds to each of the attribute items of the second database;" These are some of the grammatical errors in the claim limitations. Applicant is advised to check for other grammatical errors. It is noted, Claims 1 and 7 contain 112 second paragraph lack of antecedent basis issues.

In response to Applicant's arguments:

Applicant argues: Salkewicz and Woodhill are not seen to disclose or suggest, when copying data selected from a first database to a second database, determining if each of the attribute items of attribute information appended to the data corresponds to each of the attribute items of the second database, and then copying information of an attribute item, which is determined to correspond to one of the attribute items of the second database, to a corresponding attribute item of the second database, and copying information of an attribute item that is determined not to correspond to any of the attribute items of the second database, to the predetermined attribute item of the second database has been considered but is not persuasive because it is interpreted that Salkewicz teaches "when copying data selected from a first database to a second database" in col. 2, lines 47-50 ("... copying each segment to a storage device and transmitting the segment copy from the storage device to the second database"), determining if each of the attribute items of attribute information appended to the data corresponds to each of the attribute items of the second database in col. 4, lines 55-67 and col. 5, lines 1-5.

Salkewicz fails to teach, then copying information of an attribute item, which is determined to correspond to one of the attribute items of the second database, to a corresponding attribute item of the second database, and copying information of an attribute item that is determined not to correspond to any of the attribute items of the second database, to the predetermined attribute item of the second database. Woodhill teaches, then copying information of an attribute item, which is determined to correspond to one of the attribute items of the second database, to a corresponding attribute item of the second database, and copying information of an attribute item that is determined not to correspond to any of the attribute items of the second database, to the predetermined attribute item of the second database in col. 2, lines 20-38, col. 9, lines 49-67 and col. 10, lines 1-13.



VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

DETAILED ACTION

1. Claims 1, 3-12, and 14-31 are pending. Claim 15 has been amended in this communication filed 11/21/02 entered as Amendment C, paper no. 18.
2. The Claim Objection to claim 15 has been overcome by Applicant's amendment to the claim and is hereby withdrawn.
3. The Objection to the Specification has been overcome by Applicant's amendment to drawing fig. 1 (108), fig. 8 (S46) have been overcome by the Drawing Changes filed 11/21/02, entered as Drawing Changes, paper no. 17 and Applicant's fig. 2 (11), fig. 6 (S24) being pointed to in the Specification has been considered and the Objections are hereby withdrawn.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-12, and 14-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Salkewicz et al (US 5,970,502), hereafter Salkewicz in view of Woodhill et al (US 5,649,196), hereafter Woodhill.

With respect to claims 1, 12, 23, and 26, Salkewicz teaches, a first copying means for copying data selected from a first database to a second database (col. 2, lines 39-50); and a determination means for determining if the attribute items of attribute

information appended to the data corresponds to each of the attribute items of the second database (col. 4, lines 55-67).

Salkewicz did not teach, a second copying means for copying information of an attribute item, determined by the determination means to correspond to one of the attribute items of the second database, to a corresponding attribute item of the second database, and for copying information of an attribute item that is determined by the determination means not to correspond to any of the attribute items of the second database, to the predetermined attribute item of the second database.

Woodhill discloses, a second copying means for copying information of an attribute item, determined by the determination means to correspond to one of the attribute items of the second database, to a corresponding attribute item of the second database, and for copying information of an attribute item that is determined by the determination means not to correspond to any of the attribute items of the second database, to the predetermined attribute item of the second database (col. 2, lines 20-38, col. 9, lines 49-67 and col. 10, lines 1-13). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a second copying means for copying information of an attribute item, determined by the determination means to correspond to one of the attribute items of the second database, to a corresponding attribute item of the second database, and for copying information of an attribute item that is determined by the determination means not to correspond to any of the attribute items of the second database, to the predetermined attribute item of the second database and to combine Salkewicz's a first copying means for copying data selected from a first database to a second database and a determination means for determining if the attribute items of attribute information appended to the data corresponds to each of the attribute items of the second database

with a second copying means for copying information of an attribute item, determined by the determination means to correspond to one of the attribute items of the second database, to a corresponding attribute item of the second database, and for copying information of an attribute item that is determined by the determination means not to correspond to any of the attribute items of the second database, to the predetermined attribute item of the second database and to modify in Salkewicz's because such a modification would allow Salkewicz to have a backup/restore system that is capable of operating on a networked computer system and capable of accommodating a large array of storage devices with the attribute item represented as regular data, attribute data, or a control list of data in a database.

With respect to claims 3, 10, and 14, Salkewicz and Woodhill did not teach,... copying the information of the attribute item does not correspond to any of the attribution items the second database to the predetermined item in a predetermined format indicating information of a mismatching attribute item, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to ... copying the information of the attribute item does not correspond to any of the attribution items the second database to the predetermined item in a predetermined format indicating information of a mismatching attribute item and to modify in Salkewicz and Woodhill because such a modification is well known in the art when copying information of an attribute from a first database to a second database if the databases contain different information the attributes will not match. For example, if one database contains US patents and the other database contains Japanese patents, the patent numbers and the dates (attribute items) will not correspond (mismatched) when copied from the US patents database to the Japanese patents database

With respect to claims 4 and 15, Salkewicz did not teach, the predetermined format indicates an attribute item name and contents. Woodhill discloses, the predetermined format indicates an attribute item name and contents (col. 3, lines 52-63 & fig. 3, steps 40, 44, 48, 50, 52, 54, & 57). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the predetermined format indicate an attribute item name and contents and to modify in Salkewicz because such a modification would allow Salkewicz to have a file identification (contents), a record type, a file location, a file name (attribute item).

With respect to claim 5, Salkewicz did not teach, ... the second copying means detects attribute information stored in the predetermined attribute item in a predetermined format recovering the attribute information on the basis of the attribute item name and contents indicated by the information. Woodhill discloses, ... the second copying means detects attribute information stored in the predetermined attribute item in a predetermined format recovering the attribute information on the basis of the attribute item name and contents indicated by the information (col. 9, lines 36-67 and col. 10, lines 1-12). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have ... the second copying means detect attribute information stored in the predetermined attribute item in a predetermined format recovering the attribute information on the basis of the attribute item name and contents indicated by the information and to modify in Salkewicz because such a modification would allow Salkewicz to have at least one copy of the contents that is stored and if a disaster should destroy an entire site not all of the copies of the site's data would be destroyed.

With respect to claims 6, 11, 17, and 22, Salkewicz teaches, ... holding conversion information indicating a correspondence between attribute items of the first

and second databases and the determination means determines based on the conversion information indicating a correspondence between attribute items of the first and second databases (col. 7, lines 31-42) and wherein the determination means determines based on the conversion information if each of the attribute items of the attribute information appended to the data corresponds to each of the attribute items of the second database (col. 7, lines 43-49).

With respect to claims 7, 8, 18, 19, 24, 25, 27, and 28, Salkewicz teaches, the first copying means for copying data selected from a first database to a second database (col. 3, lines 52-63); ... determining if the attribute items of attribute information appended to the data can be set into the second database (col. 4, lines 60-67 and col. 5, lines 1-5); and information recovery means for when attribute information stored in the predetermined attribute item in the predetermined format is detected upon copying data from the backup database to one of the plurality of databases, recovering the attribute information on the basis of an attribute item name and contents thereof indicated by the information (col. 6, lines 8-60). Salkewicz did not teach, ... copying information of an attribute item determined by the determination step to not correspond to any of the items in a second database to a predetermined attribute item of the second database. Woodhill discloses ... copying information of an attribute item determined by the determination step to not correspond to any of the items in a second database to a predetermined attribute item of the second database (col. 2, lines 20-38 and col. 9, lines 49-67 and col. 10, lines 1-13. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have ... copying information of an attribute item determined by the determination step to not correspond to any of the items in a second database to a predetermined attribute item of the second database and to combine Salkewicz's the first copying means for copying data selected from a first

database to a second database; ... determining if the attribute items of attribute information appended to the data can be set into the second database; and information recovery means for when attribute information stored in the predetermined attribute item in the predetermined format is detected upon copying data from the backup database to one of the plurality of databases, recovering the attribute information on the basis of an attribute item name and contents thereof indicated by the information with Woodhill's ... copying information of an attribute item determined by the determination step to not correspond to any of the items in a second database to a predetermined attribute item of the second database because such a modification in Salkewicz would allow the information to be converted from the first database to the second database and each first database or primary database to have a corresponding mirror database for backup or archiving and recovering information when a computer system failure occurs.

With respect to claims 9 and 21, Salkewicz did not teach, when an attribute item which is not set in the conversion information is found, ... copying means copies the attribute item and attribute information thereof to a predetermined attribute item in the second database. Woodhill discloses, when an attribute item which is not set in the conversion information is found, ... copying means copies the attribute item and attribute information thereof to a predetermined attribute item in the second database (col. 1, lines 27-45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have when an attribute item which is not set in the conversion information is found, ... copying means copies the attribute item and attribute information thereof to a predetermined attribute item in the second database and to combine Salkewicz's first copying means for copying data selected from a first database to a second database with Woodhill's when an attribute item which is not set in the conversion information is found, ... copying means copies the attribute item and attribute

information thereof to a predetermined attribute item in the second database and to modify in Salkewicz because such a modification in Salkewicz would allow Salkewicz to have a backup system that operates by making copies of a computer systems files on a special backup input/output device and the file name to be derived from the original file from the date/time of the backup operation.

With respect to claim 16, Salkewicz did not teach, recovering the attribute information based on the attribute of the item name and contents indicated by the attribute information when the attribute information is stored in the predetermined attribute item in a predetermined format is detected in the second copying step. Woodhill discloses, recovering the attribute information based on the attribute of the item name and contents indicated by the attribute information when the attribute information is stored in the predetermined attribute item in a predetermined format is detected in the second copying step (col. 10, lines 21-44). It would have been obvious to one having ordinary skill in the art at the time the invention was made to recover the attribute information based on the attribute of the item name and contents indicated by the attribute information when the attribute information is stored in the predetermined attribute item in a predetermined format is detected in the second copying step and to combine Salkewicz's information recovery means for when attribute information stored in the predetermined attribute item in the predetermined format is detected upon copying data from the backup database to one of the plurality of databases with Woodhill's recovering the attribute information based on the attribute of the item name and contents indicated by the attribute information when the attribute information is stored in the predetermined attribute item in a predetermined format is detected in the second copying step and to modify in Salkewicz because such a modification would

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allow Salkewicz to have the backup copy maintained in the storage file for ultimate storage to magnetic tape or other low cost storage media.

With respect to claim 20, this dependent claim is rejected for the similar rationale given for claims 1, 6, 12, 23, 26, and 29.

With respect to claims 29-31, Salkewicz and Woodhill did not teach a control program comprising a code for performing the steps of claims 1, 7, and 8 as recited in claims 29-31, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a control program comprising a code because the central processing unit (CPU) performs the functions of reading and executing the program codes and a storage medium such as a CD ROM, a hard disk, a floppy disk, optical disk, and magnetic tape provides the program codes.

Response to Arguments

6. Applicant's arguments filed 11/21/02 have been fully considered but they are not persuasive.

1. Applicant argues: the applied art, namely Salkewicz and Woodhill, is not seen to disclose or suggest the foregoing features of independent claim 1. In particular, the applied art is not seen to disclose or suggest, when copying data selected from a first database to a second database, determining if each of attribute items of attribute information appended to the data corresponds to each of attribute items of the second database, and then copying information of an attribute item, which is determined to correspond to one or the attribute items of the second database, to a corresponding attribute item of the second database, and copying information of an attribute item that is determined not to correspond to any of the attribute items of the second database, to the predetermined attribute item of the second database has been considered but is not

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persuasive because it is interpreted that Salkewicz teaches, a first copying means for copying data selected from a first database to a second database (col. 2, lines 39-50- "... copying each segment to a storage device (from a first database) and transmitting the segment copy from the storage device to the second database"); and a determination means for determining if the attribute items of attribute information appended to the data corresponds to each of the attribute items of the second database (col. 4, lines 55-67). Salkewicz did not teach, a second copying means for copying information of an attribute item, determined by the determination means to correspond to one of the attribute items of the second database, to a corresponding attribute item of the second database, and for copying information of an attribute item that is determined by the determination means not to correspond to any of the attribute items of the second database, to the predetermined attribute item of the second database.

Woodhill discloses, a second copying means for copying information of an attribute item, determined by the determination means to correspond to one of the attribute items of the second database, to a corresponding attribute item of the second database, and for copying information of an attribute item that is determined by the determination means not to correspond to any of the attribute items of the second database, to the predetermined attribute item of the second database (col. 2, lines 20-38, col. 9, lines 49-67 and col. 10, lines 1-13). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a second copying means for copying information of an attribute item, determined by the determination means to correspond to one of the attribute items of the second database, to a corresponding attribute item of the second database, and for copying information of an attribute item that is determined by the determination means not to correspond to any of the attribute items of the second database, to the predetermined attribute item of the second database and to

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combine Salkewicz's a first copying means for copying data selected from a first database to a second database and a determination means for determining if the attribute items of attribute information appended to the data corresponds to each of the attribute items of the second database with a second copying means for copying information of an attribute item, determined by the determination means to correspond to one of the attribute items of the second database, to a corresponding attribute item of the second database, and for copying information of an attribute item that is determined by the determination means not to correspond to any of the attribute items of the second database, to the predetermined attribute item of the second database and to modify in Salkewicz's because such a modification would allow Salkewicz to have a backup/restore system that is capable of operating on a networked computer system and capable of accommodating a large array of storage devices with the attribute item represented as regular data, attribute data, or a control list of data in a database.

2. Applicant argues: Applicant respectfully submits that Salkewicz and Woodhill, either alone or in combination, are not seen to provide any motivation or hint to reach the combination of the invention of independent claim 1 where it is determined if each of attribute items of the first database corresponds (matches) to each of attribute items of the second database, and information of an attribute item of the first database that is determined not to correspond (not to match or mismatch) to any of the attribute items of the second database is copied to a predetermined attribute item of the second database has been considered but is not persuasive based on the fact that as for example, if one database (the first database) contains U. S. patents with different patent numbers and dates (attribute items) and the Japanese database (second database) will

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not have patent numbers and dates that correspond (match) when copied from the first database to the second database. This is not a comparison but a copying from one database to another database where the attribute items do not correspond.

In conclusion: Applicant has failed to appreciate the breadth of the claims. In particular "the copying operation between the databases which have different sets of attribute items" ("where it is determined if each of the attribute items of the first database corresponds to each of the attribute items of the second database, and information of an attribute item of the first database that is determined not to correspond to any of the attribute items of the second database is copied to a predetermined attribute item of the second database").

Response to the argument regarding motivation: The motivation need not be expressed in a reference used to show obviousness. It is assumed that which is not taught in the reference relies to some extent on the knowledge of persons skilled in the art to complement that which is known and the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied reference.

Sources of Rationale Supporting a Rejection under 35 U.S.C. 103: Rationale may be in a reference, or reasoned from common knowledge in the art, scientific principles, art- recognized equivalents, or legal precedent. See MPEP 2144.

In this rejection of claim 1 and others above, for example under Section 103 of Title 35 of United States Code the Examiner carefully drew up a correspondence between the Applicants' claimed limitations and one or more referenced passages in

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Salkewicz and Woodhill. The Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the Specification (see below):

2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPO 541,550 (CCA 1969).<

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiries

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday from 6:30 am -5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for Official communications and 703-746-5622 for Unofficial communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

E. Colbert
December 2, 2003



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

MEMORANDUM

DATE: July 25, 2003

TO: Technology Center Directors

FROM: Stephen G. Kunin 
Deputy Commissioner for Patent Examination Policy

SUBJECT: Revised Amendment Practice Final Rule Effective July 30, 2003

All amendments filed on or after the effective date noted above must comply with revised 37 CFR 1.121. See Final Rule: **Changes To Implement Electronic Maintenance of Official Patent Application Records** (68 *Fed. Reg.* 38611 (June 30, 2003)), posted on the Office's website at: <http://www.uspto.gov/web/patents/ifw/notices.html> with related information. The amendment practice set forth in revised 37 CFR 1.121, and described below, replaces the voluntary revised amendment format available to applicants since February 2003. The Office will notify applicants of preliminary and non-final amendments that are not accepted because they do not comply with revised 37 CFR 1.121 via a Notice of Non-Compliant Amendment. See MPEP 714.03 (Rev. 1, Feb. 2003). After-final amendments will be treated by examiners in advisory actions. The non-compliant section(s) of the amendment will have to be corrected and the entire corrected section(s) resubmitted within a set period.

The revised amendment practice is essentially the same as the amendment practice that the Office set forth in *AMENDMENTS IN A REVISED FORMAT NOW PERMITTED*, 1267 *Off. Gaz. Pat. Office* 106 (February 25, 2003) with some exceptions summarized here. The revised amendment practice, as distinguished from the voluntary revised amendment format, now: (1) requires the use of seven claim status identifiers (formerly eleven) including new identifiers "previously presented" and "not entered," (2) requires the inclusion of text for "withdrawn" claims and the exclusion of text for "not entered" claims in the complete listing of all claims, (3) mandates use of underlining and strikethrough for indicating changes to the specification and/or claims, (4) permits use of double brackets for the deletion of five or fewer characters or difficult to perceive text, and (5) provides for applicant's submission of, or examiner's requirement for, annotated drawing sheets in addition to the required replacement drawing sheets.

Amendments filed prior to July 30, 2003 in compliance with the previous version of 37 CFR 1.121 or the revised version promulgated in the Notice of Final Rule Making 68 *Fed. Reg.* 38611 (June 30, 2003) will be accepted. New informational flyers are being inserted with each out-going Office Action mailed during the period of June 2003 to August 2003. The flyer instructs applicants in the procedures to be used to comply with the revised practice for amendments to the claims, specification, and drawings. A copy of the flyer is included herewith for your information.

Further Assistance: Any questions regarding the submission of amendments pursuant to the revised practice should be directed to Office of Patent Legal Administration (OPLA) Legal Advisors, Elizabeth Dougherty (Elizabeth.Dougherty@uspto.gov), Gena Jones (Eugenia.Jones@uspto.gov) or Joe Narcavage (Joseph.Narcavage@uspto.gov). Alternately, you may send e-mail to patentpractice@uspto.gov, the OPLA e-mail address that has been established for receiving queries and questions about patent practice and procedures or telephone OPLA at 703.305.1616.

Attachment: Flyer – *Revised Amendment Practice: 37 CFR 1.121 Changed (Rev. 3, 7/24/03)*

REVISED AMENDMENT PRACTICE: 37 CFR 1.121 CHANGED COMPLIANCE IS MANDATORY - Effective Date: July 30, 2003

All amendments filed on or after the effective date noted above must comply with revised 37 CFR 1.121. See Final Rule: **Changes To Implement Electronic Maintenance of Official Patent Application Records** (68 Fed. Reg. 38611 (June 30, 2003)), posted on the Office's website at: <http://www.uspto.gov/web/patents/ifw/> with related information. The amendment practice set forth in revised 37 CFR 1.121, and described below, replaces the voluntary revised amendment format available to applicants since February 2003. **NOTE: STRICT COMPLIANCE WITH THE REVISED 37 CFR 1.121 IS REQUIRED AS OF THE EFFECTIVE DATE (July 30, 2003).** The Office will notify applicants of amendments that are not accepted because they do not comply with revised 37 CFR 1.121 via a Notice of Non-Compliant Amendment. See MPEP 714.03 (Rev. 1, Feb. 2003). The non-compliant section(s) will have to be corrected and the entire corrected section(s) resubmitted within a set period.

Bold underlined italic font has been used below to highlight the major differences between the revised 37 CFR 1.121 and the voluntary revised amendment format that applicants could use since February, 2003.

Note: The amendment practice for reissues and reexamination proceedings, except for drawings, has not changed.

REVISED AMENDMENT PRACTICE

I. Begin each section of an amendment document on a separate sheet:

Each section of an amendment document (e.g., Specification Amendments, Claim Amendments, Drawing Amendments, and Remarks) must begin on a separate sheet. Starting each separate section on a new page will facilitate the process of separately indexing and scanning each section of an amendment document for placement in an image file wrapper.

II. Two versions of amended part(s) no longer required:

37 CFR 1.121 has been revised to **no longer require** two versions (a clean version and a marked up version) of each replacement paragraph or section, or amended claim. Note, however, the requirements for a clean version and a marked up version for **substitute specifications** under 37 CFR 1.125 have been retained.

A) Amendments to the claims:

Each amendment document that includes a change to an existing claim, cancellation of a claim or submission of a new claim, **must include a complete listing** of all claims in the application. After each claim number in the listing, the status must be indicated in a parenthetical expression, and the text of each pending claim (with markings to show **current** changes) must be presented. The claims in the listing will replace all prior claims in the application.

- (1) The current status of all of the claims in the application, including any previously canceled, not entered or withdrawn claims, must be given in a parenthetical expression following the claim number using only one of the following seven status identifiers: (original), (currently amended), (canceled), (withdrawn), (new), **(previously presented) and (not entered)**. The text of all pending claims, **including withdrawn claims**, must be submitted each time any claim is amended. Canceled **and not entered** claims must be indicated by only the claim number and status, without presenting the text of the claims.
- (2) The text of all claims **being currently amended** must be presented in the claim listing with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for **deletion of five characters or fewer, double brackets may be used (e.g., [[eroor]])**; and (2) if **strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]])**. **As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., number 4 as number 14 as)**. An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended," and "withdrawn" that are being amended, may include markings.
- (3) The text of pending claims **not being currently amended, including withdrawn claims**, must be presented in the claim listing in clean version, i.e., without any markings. Any claim text presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims.

- (4) A claim being canceled must be listed in the claim listing with the status identifier "canceled"; the text of the claim must not be presented. Providing an instruction to cancel is optional.
- (5) Any claims added by amendment must be presented in the claim listing with the status identifier "(new)"; the text of the claim must not be underlined.
- (6) All of the claims in the claim listing must be presented in ascending numerical order. Consecutive canceled, or not entered, claims may be aggregated into one statement (e.g., Claims 1 – 5 (canceled)).

Example of listing of claims (use of the word "claim" before the claim number is optional):

Claims 1-5 (canceled)

Claim 6 (previously presented): A bucket with a handle.

Claim 7 (withdrawn): A handle comprising an elongated wire.

Claim 8 (withdrawn): The handle of claim 7 further comprising a plastic grip.

Claim 9 (currently amended): A bucket with a ~~green~~ blue handle.

Claim 10 (original): The bucket of claim 9 wherein the handle is made of wood.

Claim 11 (canceled)

Claim 12 (not entered)

Claim 13 (new): A bucket with plastic sides and bottom.

B) Amendments to the specification:

Amendments to the specification, including the abstract, must be made by presenting a replacement paragraph or section or abstract marked up to show changes made relative to the immediate prior version. An accompanying clean version is not required and should not be presented. Newly added paragraphs or sections, including a new abstract (instead of a replacement abstract), must not be underlined. A replacement or new abstract must be submitted on a separate sheet, 37 CFR 1.72. If a substitute specification is being submitted to incorporate extensive amendments, both a clean version (which will be entered) and a marked up version must be submitted as per 37 CFR 1.125.

The changes in any replacement paragraph or section, or substitute specification must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for deletion of five characters or fewer, double brackets may be used (e.g., [[eroor]]); and (2) if strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., number 4 as number 14 as)

C) Amendments to drawing figures:

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment, and may be accompanied by a marked-up copy of one or more of the figures being amended, with annotations. Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet" and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. Any marked-up (annotated) copy showing changes must be labeled "Annotated Marked-up Drawings" and accompany the replacement sheet in the amendment (e.g., as an appendix). The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Questions regarding the submission of amendments pursuant to the revised practice set forth in this flyer should be directed to: Elizabeth Dougherty or Gena Jones, Legal Advisors, or Joe Narcavage, Senior Special Projects Examiner, Office of Patent Legal Administration, by e-mail to patentpractice@uspto.gov or by phone at (703) 305-1616.